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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,815	02/27/2002	Charles E. Narad	42390P8220C3C	8873

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EXAMINER	
HARRELL, ROBERT B	

ART UNIT	PAPER NUMBER
2142	4

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/084,815	NARAD ET AL.	
	Examiner	Art Unit	
	Robert B. Harrell	2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *2/27/02 et al.*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-51* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 February 2002* is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 2.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: *see attached Office Action*.

Serial Number: 10/084,815
Art Unit : 2142

1. Claims 1-51 are presented for examination.

2. The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Van Ornam, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

3. A timely filed terminal disclaimer in compliance with 37 C.F.R. 1.321 (c) may be used to overcome an actual or provisional rejection based on a non-statutory based double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. 3.73(b).

4. Claims 1-51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-54 of U.S. Patent No. 6,421,730 B1 (Narad et al.). Although the conflicting claims are not word for word identical, they are not patentably distinct from each other because of the reasons outline below.

5. Although the wording between the claimed subject matter of this application and those of the patented claim are not word for word identical, the claimed subject matter of this application encompasses the scope of the patented claims since the claims of this application are broader in scope by duplicating and then removing limitations found in the patented claims and by

renaming elements. A test for double patenting is if the patent claims literally infringe on the application claims. In this case the broaden claims of this application would be literally infringed upon by the more narrow scoped claims of the patent.

6. Specifically, claim 1 of this application is a duplicate of claim 28 of the patent with the last three lines of claim 28 of the patent removed to form claim 1 of this application. Also renaming the same elements, as in claim 1 of this application ("processing means") and claim 28 of the patent ("facility"), still results in the same claimed scope of claim 28 in the patent. Since deletion of the last three lines of claim 28 in the patent and renaming elements results in a claim of this application being literally infringed upon by the patented claim, an obviousness type double patenting is proper.

7. Per claim 2 of this application, since lines 7-8 of claim 28 in the patent calls for the plurality of action and classification engines (ACEs) to have two or more instances of a particular ACE while claim 2 of this application calls for two or more different ACEs, claim 2 of this application is broader in scope then claim 28 of the patent for the following reason/logic. To meet claim 28 there must be a plurality of action and classification engines (ACEs) such as in a set ACE(1), ACE(1),

ACE(2), ACE(3), ACE(4). Here there are a plurality of ACEs and two of the instances are of a particular ACE; specifically ACE(1). Claim 2 of this application also calls for a plurality of ACEs but include instances of two or more difference ACEs such as in the set ACE(1), ACE(2), ACE(3), ACE(4). Here there are two or more difference ACES different then ACE(1) such as ACE(2), ACE(3), ACE(4). From inspection, if an ACE(1) of claim 28 of the patent is removed from the set of ACEs, the result is the same as the set of ACEs in claim 2 of this application. Thus claim 2 is broader and thus literally infringed upon by the more narrowed claim 28 of the patent. That is, a claim with elements A,B,C, and D literally infringes a claim with only the elements A,B,C.

8. Per claim 3 of this application, such is found in claim 28 of the patent last three lines. In other words, claims 1 and 3 of this application form claim 28 of the patent.

9. As for claims 4-15, they map as follows with the first claim on each line being those of this application followed on the same line with the claim number of the patent:

4,39
5,29
6,30
7,40
8,31
9,32
10,33
11,34
12,35
13,36
14,37
15,38

10. Per claims 16 and 17 of this application, such are inherently required to allow for the communications between the PEs that contain the ACEs per claim 28 (lines 6 and 7). "DEMUX" is routing one message from several messages over a single path to elements downstream as covered in claim 38 of the patent "downcalls".

11. Since claims 1-27 and 41-54 of the patent claims do not teach or defined above the corresponding claims of 28-40 of the patent claims, claims 1-17 of this application are also infringed upon by claims 1-27 and claims 41-54 of the patent claims.

12. As for claims 18-51 of this application, since they do not teach or define above the correspondingly rejected claims 1-17 of this applications given above, they too are infringed upon by claims 1-54 of the patent claims.

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(e) the invention was described in-
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the

United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a); or

14. Claims 1-51 are is rejected under 35 U.S.C. 102 (e) as being clearly anticipated by Vaid et al. (6,078,953).

15. Per claims 1 and 2, Vaid taught a platform for processing a partitioned network infrastructure application (eg., see figure 2, Abstract, col. 9 (lines 32-38)), comprising:

) a first processing means for processing an application processor module (AP) (eg., see figure 2 (201,224, and 225 (such as "Security Applications"));

b) a second processing means (eg., see col. 9 (lines 32-38)) for processing a policy engine (PE) module (208 in figure 2), wherein the policy engine module included a plurality of ACEs ("Security", "Traffic" and "Other") including two or more instances of a particular ACE (col. 12 (lines 59-61) which was also a particular instance of the traffic policy (202 of figure 2) and thus at least two) and including two or more instances of different ACEs --action and classification (201 "Security" was a different instance from these others 202,203,205,217,219,221) (eg., see col. 9 (line 51) to col. 10 (line 8), and col. 13 (lines 6-12) while the security policy (201) was also different).

16. Per claim 3, Vaid also taught a messaging (223 API of figure

2) facility supporting compunction between the application processor module and the policy engine module (eg., see col. 9 (lines 45-51)).

17. Per claim 4, see figure 8 (805 follows 803 and thus serial) (eg., see col. 15 (line 61) to col. 16 (line 63).

18. Per claim 5, figure 2 (21) were user defined actions via parameters (eg., see col. 12 (line 51-56)).

19. Per claim 6, since the system of Vaid was a computer, general purpose programming language was inherently required.

20. Per claims 7-9, see col. 9 (lines 51-65). All the hardware making up a single physical resource that functions as does the software is an equivalent to the software.

21. Per claims 10-15, see figure 8 (803) and col. 16 (line 21-et seq.) where the action was the traffic flow up and/or down calls (upstream and/or down stream) among the targets (sources and destination for the packets in the traffic).

22. Per claims 16 and 17, such are inherently required to permit for the communications between the PEs. "DEMUX" is routing one selected message from several messages over a single path in the flow of traffic to elements upstream and downstream in the system.

23. Per claims 18-51, they do not teach or define above the

correspondingly rejected claims and are thus rejected for the same reasons under 35 U.S.C. 102(e) as given for claims 1-17 above.

24. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the data of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (703) 305-9692. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack B. Harvey, can be reached on (703) 308-9705. The fax phone numbers for the Group are (703) 746-7238 for After-Final, (703) 746-7239 for Official Papers, and (703) 746-7240 for Non-Official and Draft papers.

26. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142